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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/835,366 | 04/17/2001 | Cheng-Shing Lai | LAIC3001/EM/6698 | 5773 |
| 7590 | 01/25/2005 | | EXAMINER | |
| BACON & THOMAS, PLLC 625 Slaters Lane 4th Floor Alexandria, VA 22314-1176 | | | | NGUYEN, LEE |
| | | ART UNIT | PAPER NUMBER | 2682 |

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/835,366 | LAI ET AL. | |
| | Examiner | Art Unit | |
| | LEE NGUYEN | 2682 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 August 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

This action is responsive to the communication filed 08/12/2004.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Papineau et al. in view of Kraft (US 6,309,305) and Nguyen (US 5,797,089).

Regarding claim 1, Papineau teaches a method for selecting to activate a personal digital assistant (PDA) or a mobile phone in an electronic device comprising a menu containing a PDA option and a mobile phone option such that when said device is enabled, said PDA or said mobile phone option is selectable for generating a signal indicating said selection, and a central processing unit (CPU) for showing a prompt of said selected PDA option or said mobile phone option for use after receiving said signal, see [0022] – [0024]. Papineau further teaches the step of displaying a menu containing a PDA option and a mobile phone option for selection by activating a display means after powered on [0023] – [0024]; selecting one of said options by clicking through an activated input means [0024]; and inherently determining by said CPU 106 (fig. 2) which of said PDA option and said mobile phone option is selected (see [0023]-[0024]) and if said mobile phone option is selected , said CPU inherently reading a program stored in a mobile phone read only memory 218 for showing a prompt of said mobile phone, closing a switch means for commanding a transceiver

means through a control circuit 218, transmitting messages from an antenna or received by said antenna 201. Papineau does not explicitly teach operating said device for reading data from a random access memory (RAM) or writing data into said RAM. In an analogous art, Kraft teaches that RAM can be used for read/write text message (col. 2, lines 54-67 and col. 4, lines 4-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the RAM of Kraft to the apparatus of Papineau so that programs as well as data for applications can be accessed (col. 4, lines 6-15). Papineau as modified inherently teaches that said CPU 106 (fig. 2) reading a program stored in a PDA ROM if said PDA option is selected for showing a prompt of said PDA, controlling said selected PDA option by said control circuit (see [0020]). Papineau as modified fails to teach operating said device for reading data from said RAM or writing data into said RAM. In other words, Papineau as modified fails to teach that the same RAM is used for both the mobile phone and the PDA. In an analogous art, Nguyen teaches that the same RAM can be commonly accessed by both the PDA and the mobile telephone (col. 4, lines 35-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the

teaching of Nguyen to the apparatus of Papineau in order to save space and cost of an extra RAM.

Response to Arguments

4. Applicant's arguments filed 08/12/2004 have been fully considered but they are not persuasive.

Applicant argues that Papineau, Kraft, and Nguyen either alone or in combination fails to teach that the communications disabled operating mode is not activated by a menu display upon power-up. Rather, the communications disabled operating mode of Papineau can only be entered after the electronic device has been powered-up and the communication devices have been on for a while.

In response, the examiner respectfully disagrees. The claim only requires displaying a menu containing a PDA option and a mobile phone option for selection by activating a display means after the electronic device is powered on, emphasis added. The claim does not recites displaying a menu contain a PDA option and a mobile phone option for selection by activating a display means upon the electronic device is powered on. Therefore, the combination of

Papineau, Kraft, and Nguyen does disclose the limitation as required by the claim.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

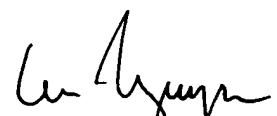
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE NGUYEN whose telephone

number is (703)-308-5249. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN CHIN can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 1/17/05
LEE NGUYEN
Primary Examiner
Art Unit 2682